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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,891	03/12/2004	Russell Smith	8618-USA	4903

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PATENT GROUP GA030-43  
GEORGIA-PACIFIC CORPORATION  
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ATLANTA, GA 30303-1847

EXAMINER

DAVIS, JENNA L

ART UNIT PAPER NUMBER

1771

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/798,891

Applicant(s)

SMITH ET AL.

Examiner

Jenna Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/2/06 and 9/26/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/17/06.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/26/06 has been entered.

### ***Response to Amendment***

Applicant's amendment filed 8/2/06 has been entered. Claim 1 has been amended. Claim 6 has been cancelled. Claims 1-5 and 7-20 are pending.

### ***Claim Objections***

Claims 7-17 are objected to because of the following informalities: Claim 7 depends from cancelled claim 6 and claims 8-17 are directly or indirectly dependent on claim 7. For the purposes of this action it will be assumed that claim 7 depends from claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-5, 7-15, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randall (US 2002/0455282) in view of Ali (US 4,647,486) substantially as set forth in section 3 on pages 2-4 of the Office action dated 5/2/06.

Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randall in view of Ali as applied to the claims above, and further in view of Babcock (US 4,746,365) substantially as set forth in section 4 on page 5 of the May 2, 2006, Office action.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Randall in view of Ali and Babcock as applied to the claims above, and further in view of Miyakoshi (US 5827788) substantially as set forth in section 5 on page 5 of the May 2, 2006 Office action.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-5 and 7-20 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 3-16, and 18-23 of copending Application No. 10/417,344 in view of Ali as set forth in section 7 on page 6 of the May 2, 2006, Office action.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claims 1-5 and 7-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6808793 in view of Ali as set forth in section 8 on page 7 of the May 2, 2006, Office action.

#### ***Response to Arguments***

Applicant's arguments filed August 2, 2006, have been fully considered but they are not persuasive.

Applicant argues that the claimed amount of 30-50% of coating penetration into the thickness of the mat is not an inherent consequence of the parameters disclosed by Randall et al. However, the Examiner has set forth a reasonable basis in the rejection for the claimed coating penetration to be inherent in the teachings of Randall et al., or at the very least, obvious to provide. Applicant has not addressed this basis.

Applicant asserts that Randall et al. do not teach the strength of the bond between the pre-coated mat facer and the core of the gypsum board is maximized when the coating lies within the range of 30 to 50%. From this, Applicant concludes that Randall does not make the claimed invention obvious. However, a direct teaching of the claimed limitation is the standard for anticipation, not obviousness. The rejection is based upon a theory of inherency or obviousness.

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Applicant attacks the Randall reference and appears to admit that the claimed values at least overlap the values of Randall. The issue here is not anticipation, but rather what a person having ordinary skill in the art would have found obvious from the teachings of the references. A person having ordinary skill in the art would reasonably have expected materials having the thicknesses, coating weights, coating compositions, etc. taught by Randall to produce a successful fiber mat faced gypsum board.

The argument regarding the bond tensile strength as exemplified in Example 3 of the present application is not persuasive because it is not commensurate in scope with the present claims.

The declaration of Mr. Randall has been considered but is not found persuasive as it does not address the Examiner's position regarding the inherency/obviousness rationale as noted above and further fails to address what a person having ordinary skill in the art in the art of gypsum board manufacture would reasonably have gleaned from the Randall reference.

Applicant argues that Ali does not suggest the exact stoichiometry of hydrated gypsum must be maintained across the entire cross-section of the commercially produced gypsum board either to maintain the desired structural properties of the board or to maintain effectiveness of the board as a fire barrier. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., stoichiometry of hydrated gypsum maintained across the entire cross-section) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Applicant argues that Ali does not suggest any particular limit on surface calcinations that unavoidably accompanies commercial board drying operations. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The arguments with regard to the obviousness-type double patenting rejections, the Examiner maintains that the claims of the '344 application and the '793 patent since Ali expressly suggests providing the amount of water to result in improved fire barrier properties and this would have been appreciated by a person having ordinary skill in the art at the time the present invention was made.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna Davis whose telephone number is 571-272-3357. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jenna Davis  
Primary Examiner  
Art Unit 1771

jld